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09/644,560	08/24/2000	Patrick A. Forte	A7809	2556

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EXAMINER

GREENE, DANIEL L

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application N .

09/644,560

Applicant(s)

FORTE, PATRICK A.

Examiner

Daniel L. Greene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☒ Claim(s) 1-10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-10 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-10 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure, which goes to make up the device, must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Randle et al. U.S. Patent 6,594,647B1 [Randle '647].

As per claim 1.

Randle '647 discloses:

a plurality of devices by which a customer can access his individual program account ("IPA"); Col. 11, lines 60-65, Col. 12, lines 1-10.

an IPA representing an array of activities that have been individually selected by the customer from the totality of the activities in the PA; Col. 11, lines 20-30.

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a host processor for executing transaction instructions and maintaining individual program account information, said host processor including a database for maintaining individual program account transactions and records; Col. 4, lines 1-67.

means for establishing and maintaining a plurality of customer individual program accounts; Col. 3, lines 47-55.

means to support of a customers' transactional interchange of individual program account debits and credits and to settle said transactions. Col. 3, lines 53-67.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Randle '647 as applied to claim 1 above, and further in view of McKeen et al. U.S. Patent 6,529,880B1 [McKeen '880]

As per claim 2.

Randle '647 discloses the claimed invention except for a plurality of stored value accounts maintained by a merchant for a plurality of customers each having an IPA.

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McKeen '880 teaches that it is known in the art to provide a plurality of stored value accounts maintained by a merchant for a plurality of customers each having an IPA. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the real time bank-centric universal payment system of Randle '647 with the plurality of stored value accounts maintained by a merchant for a plurality of customers of McKeen '880, Col. 7, lines 25-35, in order to simplify and expedite the transaction between the customer and the merchant.

As per claim 3.

Randle '647 further discloses;

a plurality of demand deposit accounts maintained by a plurality customers in a federally insured banks as a component of an IPA. Col. 9, lines 54-60.

As per claim 4.

Randle '647 further discloses;

a plurality of point of sale terminals by which a customer may convert the value of a negotiable instrument to a customer's SVA. Col. 7, lines 28-45.

As per claim 5.

Randle '647 further discloses;

an array of mechanisms by which customers may convert value from one account in their IPA to another account in said IPA. Col. 5, lines 35-67.

As per claim 6.

Randle '647 further discloses;  
enabling said merchant to utilize point of sale terminals to access services to  
verify a check presented by a customer to the merchant. Col. 10, lines 44-67.

As per claim 7.

Randle '647 further discloses;  
establishing a merchant DDA account and providing said merchant access to the  
merchant DDA. Col. 7, lines 10-26.

As per claim 8.

Randle '647 further discloses;  
enabling said merchant to credit to a customer's SVA an amount based on the  
value of a negotiable instrument presented to the merchant by the customer. Col. 9,  
lines 17-50.

As per claim 9.

Randle '647 further discloses;  
enabling a customer to access their SVA to credit or debit other accounts in their  
IPA. Col. 11, lines 20-30.

As per claim 10.

Randle '647 further discloses;

enabling a customer to utilize the value in the customer's SVA and instruct the merchant to credit the customer's DDA at a bank with funds from said merchant's DDA.

Col. 7, lines 65-67, Col. 8, lines 1-19.

As per claim 11.

Randle '647 discloses the claimed invention, as discussed above, except for the designation of the various accounts unique to the Applicants own terms designation. i.e. IPA, SVA, and PA . PTO's guide lines for examining claimed language require: the examiner must make a determination, whether the claimed invention " as a whole" would have been obvious at the time of the invention to one of ordinary skill in the art. See MPEP 2142. In these pending claims, the examiner submits that the particular language does not serve as a limitation on the claim (i.e., "IPA, SVA, and PA". It would have been an obvious matter of design choice to modify the teachings of "Randle '647.", to substitute the Applicant's terminology for other terms conveying the same meaning, i.e. SVA-prepaid, IPA-customer account, PA-account. Since the applicant has not disclosed that designating the various accounts by his designation, solves any stated problem in a new or unexpected way or is for any particular purpose which is unobvious to one of ordinary skill and it appears that the claimed feature does not distinguish the invention over similar features in the prior art since, the teachings of Randle '647 will perform the invention as claimed by the applicant with any means, method, or product

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to establishing a customer IPA, establishing a customer DDA, establishing a merchant SVA, and a transaction between said consumer and said merchant affecting the account balances in said customer SVA, said customer DDA and said merchant accounts. Col. 4-6, lines 1-67.

As per claim 12.

Randle '647 further discloses;  
establishing a customer SVA. Col. 7, lines 10-26.

As per claim 13.

Randle '647 further discloses;  
establishing within said IPA. Col. 7, lines 10-26.

As per claim 14.

Randle '647 further discloses;  
wherein said transaction comprising the presentation of a negotiable instrument at a point of sale at said merchant, to credit or debit account balances. Col. 11, lines 30-45.

As per claim 15.

Randle '647 further discloses;

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comprising the step of providing customer access to the customer DDA and said customer IPA accounts to convert balances from one account to another account. Col. 11, lines 30-45.

As per claim 16.

Randle '647 further discloses;

comprising the step of providing merchant access to the merchant SVA to convert a balance to said customer DDA. Col. 11, lines 30-60.

As per claim 17.

Randle '647 further discloses;

comprising the step of establishing a merchant DDA. Col. 11, lines 30-67.

As per claim 18.

Randle '647 further discloses;

comprising the steps of a transaction of converting a balance from the merchant DDA to said customer DDA. Col. 11, lines 30-67.

As per claim 19.

Randle '647 further discloses;

comprising a transaction wherein said customer presents a negotiable instrument at a point of sale at said merchant, said transaction including the acceptance of the

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negotiable instrument by the merchant, a corresponding value corresponding to the negotiable instrument credited to the customer SVA and payment for the purchase of goods from said merchant. Col. 10, lines 44-67, Col. 11, lines 1-30.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Thomas et al. US 6,317,745B1-TRUSTED THIRD PARTY DATA STRUCTURE FOR ELECTRONIC FUNDS TRANSFER AND BILL PRESENTATION.

Kight et al. US 5,873,072- SYSTEM AND METHOD FOR ELECTRONICALLY PROVIDING CUSTOMER SERVICES INCLUDING PAYMENT OF BILLS, FINANCIAL ANALYSIS AND LOANS.

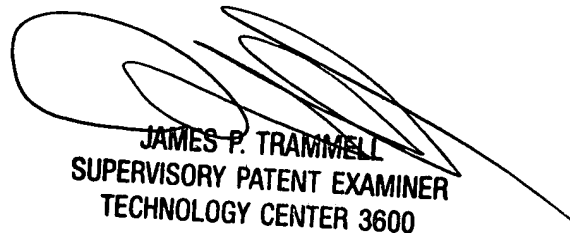
Rosen US 6,122,625A- APPARATUS AND METHOD FOR SECURE TRANSACTING.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 703-306-5539. The examiner can normally be reached on M-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

DLG  
July 24, 2003



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